



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of :
: **Docket No. 1005-AGGUS3**
LALIT K. AGGARWAL :
: **MAIL STOP ISSUE FEE**
U.S. Appln. No. 09/701,195 :
: :
Filed: November 27, 2000 :
: **Confirmation No. 7762**
For: METHOD AND ASSOCIATED :
: **APPARATUS FOR THE STANDARDIZED** :
: **GRADING OF GEMSTONES** :

COMMUNICATION

In the Notice of Allowability mailed on September 16, 2004, the Examiner indicated that the Information Disclosure Statement filed on August 9, 2004 failed to comply with the requirements of 37 CFR 1.98(a)(2) because it did not include a copy of the foreign patent document and each publication listed on the Form PTO-1449. However, the facts of this case indicate otherwise. More specifically, the Applicant included the following item on the return receipt postcard: "Supplements IDS, including Form PTO-1449 and copies of listed documents." A copy of the postcard which was date stamped by the USPTO on August 11, 2004 at 3:35 pm is enclosed with this communication. The USPTO's date stamp on the return receipt postcard makes it clear that the foreign patent and publication documents submitted with the supplemental information disclosure statement were received in the USPTO. Therefore, it appears that the submitted documents could not be considered by the Examiner because they were lost at the USPTO.

In the Notice of Allowability the Examiner communicated his apologies for the loss of the submitted documents. He indicated that the Applicant should forward new copies of the lost documents so that the application process could be completed. Accordingly, the Applicant is submitting herewith copies of the documents listed on the

Form PTO-1449 previously submitted with the information disclosure statement filed on August 9, 2004. A copy of the Form PTO-1449 is also enclosed for the Examiner's convenience.

Applicant believes that the documents provided herewith should be considered notwithstanding the provisions of 37 CFR 1.97. The Applicant fully complied with the requirements of 37 CFR 1.97(b) by timely filing the information disclosure statement in this application on March 2, 2001. This application is the U.S. national phase of International Application No. PCT/US99/11500, filed May 25, 1999. The international application properly claims the benefit of the filing date of prior U.S. patent application No. 09/085,797, filed May 28, 1998, now U.S. Patent No. 6,020,954, which was still pending at the international filing date. A copy of the preliminary amendment adding the cross-reference to the earlier filed application is enclosed herewith.¹

An information disclosure statement complying with 37 CFR 1.98(a)-(c) was submitted in the earlier filed application. All of the documents submitted in the present application were previously submitted in that information disclosure statement. Therefore, the Applicant was not required to provide copies of the documents listed on the PTO-1449 submitted on March 2, 2001 pursuant to 37 CFR 1.98(d) in the present case.

The Examiner failed to indicate in the first Office Action in the present case whether the prior art in the related earlier application was reviewed. Consequently, the

¹ Applicant notes that the filing date of the parent application is incorrectly stated as May 28, 1999. An amendment under 37 CFR 1.312 is being submitted concurrently herewith to correct that error.

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Examiner R. M. PUNNOOSE
Art Unit 2877

Applicant was not aware that the foreign patent document and the non-patent documents were not available to the Examiner until the issuance of the Office Action mailed on July 28, 2004, more than three (3) years after the Information Disclosure Statement was submitted.

The Information Disclosure Statement filed on August 9, 2004 was a resubmission of the foreign patent document and the publications originally disclosed in 2001. It would be manifestly unfair to require the Applicant to pay the fee required by 37 CFR 1.97(d) in order to have the documents considered now, when the problem could have been resolved earlier and when the documents were clearly lost by the USPTO. In this regard, it is noted that 37 CFR 1.97(f) provides that if a *bona fide* attempt is made to comply with 37 CFR 1.98, but part of the required content is inadvertently omitted, then additional time may be given to enable full compliance. In view of all the circumstances of the present case, it is believed that the documents submitted herewith should be considered by the Examiner without further expense by the Applicant.

Respectfully submitted,

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Enclosures

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		Anderson, B.W., Gem Testing, Heywood & Company Ltd., 6 th Ed. (1958)
		Liddicoat, R.T., Handbook of Gem Identification, Gemological Institute of America (1966)
		Matlins A. et al., Gem Identification Made Easy, Gemstone Press, Woodstock, Vermont (1994)
		Russ, J.C., The Image Processing Handbook, 2 nd Ed., CRC Press, Chicago (1995)
		Theisen, V.P., Diamond Grading ABC, Rubin & Son, Belgium, 11 th Ed., (1993)

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw 1 citation if not in conformance and not considered. Include copy of this form with next communication to